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10/574,205	04/25/2007	David Roy Winterbottom	MCI-8105	5560

7590 11/12/2009
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EXAMINER

AMARI, ALESSANDRO V

ART UNIT	PAPER NUMBER
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2872

MAIL DATE	DELIVERY MODE
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11/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,205

Applicant(s)

WINTERBOTTOM ET AL.

Examiner

ALESSANDRO AMARI

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
4a) Of the above claim(s) 45-50 and 55-73 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 39-44, 51-54 and 74-76 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/20/2009
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 45-50 and 55-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 September 2009.

Drawings

2. The drawings are objected to because Figure 1A is hand drawn and has labels which are illegible; Figure 1B, has handwritten labels and element numbers which are illegible, Figures 2A and 2B have handwritten labels in and around the rectangular boxes which are not legible and the first Figure 3 (shown on the same drawing sheet as Figure 1A) appears to be canceled and should be removed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: the specification lacks the proper headings. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Information Disclosure Statement

3. The information disclosure statement filed 20 March 2009 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language, specifically CN1268725. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

4. Claim 41 is objected to because of the following informalities: Regarding claim 41, line 3, the phrase, "third and fourth data" lacks antecedent basis in that there is no mention of first and second data in preceding claim 39. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 39-42, 44 and 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Durst, Jr. et al (hereafter "Durst") US 2005/0063027.

In regard to claim 39, Durst discloses (see for example, Figs. 2, 3, 4, 6, 7) a data carrier comprising: a hologram (124, 148) storing data to reproduce an image of a portion of a human body characteristic of an individual; and a second data bearing device (a watermark); and wherein data stored by said second data bearing device is verifiable using data stored in said hologram as described in paragraphs [0059] - [0060], [0063], [0067], [0068], [0083] – [0088], [0092], [0094] and [0100] - [0101].

Regarding claim 40, Durst discloses that said data stored by said second data bearing device comprises first and second data, said first data being for verification of one of said first data and said image with the other, and second data being verified by said verification as described in paragraphs [0059] - [0060], [0063], [0067], [0068], [0083] – [0088], [0092], [0094] and [0100] - [0101].

Regarding claim 41, Durst discloses that said hologram stores additional data, and wherein said data stored by said second data bearing device comprises third and fourth data, said third data being for verification of one of said additional data and said third data with the other, and fourth data being verified by said verification as described in paragraphs [0059] - [0060], [0063], [0067], [0068], [0083] – [0088], [0092], [0094] and [0100] - [0101].

Regarding claim 42, Durst discloses that said image comprises a substantially two-dimensional image as described in paragraph [0109] and [0141].

Regarding claim 44, Durst discloses that said second data bearing device comprises an integrated circuit memory device as described in paragraphs [0088] and [0102].

In regard to claim 51, Durst discloses (see for example, Figs. 2, 3, 4, 6, 7) a data carrier comprising: a hologram (124, 148) storing data to reproduce an image of a graphic associated with a product; and a second data bearing device (a watermark) storing data unique to the data carrier as described in paragraphs [0059] - [0060], [0063], [0067], [0068], [0083] – [0088], [0092], [0094] and [0100] - [0101].

Regarding claim 52, Durst discloses that said data carrier is substantially planar and wherein said graphic image is spaced away from the plane of said data carrier as described in paragraphs [0063], [0068] and [0069].

Regarding claim 53, Durst discloses that said second data bearing device comprises a unique, machine-readable code as described in paragraphs [0083] – [0094].

Regarding claim 54, Durst discloses that said data carrier is substantially planar and wherein said second data bearing device defines an image spaced away from the plane of said data carrier and comprising said unique data as described in paragraphs [0063], [0068] and [0069].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst US 2005/0063027.

Regarding claim 43, Durst teaches the invention as set forth above but does not teach that said hologram comprises a volume reflection hologram. It is well known in the holographic authentication art to employ volume reflection holograms. The known technique of utilizing volume reflection holograms for data carriers would have predictably resulted in making it more difficult to copy the hologram. It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize volume reflection holograms in the data carrier of Durst in order to make it more difficult to copy the hologram so as to provide for more protection against counterfeiting.

9. Claims 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durst US 2005/0063027 in view of Baird et al (hereafter "Baird") US 3,858,977.

Regarding claims 74-76, Durst teaches the invention as set forth above but does not teach that said hologram is configured to reconstruct in a plurality of component colors; or that said plurality of component colors comprise false colors configured to aid identification or that at least one of said component colors is substantially invisible to the human eye.

Regarding claims 74-76, Baird teaches that a hologram is configured to reconstruct in a plurality of component colors; and that said plurality of component

colors comprise false colors configured to aid identification and that at least one of said component colors is substantially invisible to the human eye as described in column 3, lines 48-67, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-67 and column 7, lines 1-2.

The known technique of utilizing colors in holograms in data carriers would have predictably resulted in protection against forgery. It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize reconstructed colors from holograms as taught by Baird for the data carrier of Durst to provide additional protection against forgery.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALESSANDRO AMARI whose telephone number is (571)272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ava
06 November 2009

/Alessandro Amari/
Primary Examiner, Art Unit 2872